



## REMARKS

Claims 1-30 are pending in the present application. Claims 1-30 were subjected to a restriction requirement on June 10, 2002, from which claims 1-14 and 27 were selected. Accordingly, claims 15-26 and 28-30 were withdrawn from consideration. Of the selected claims, claims 1, 2, 6, 10-14 and 27 stand rejected. Claims 3-5 and 7-9 are objected to.

### **I. Drawings**

The Office Action states that the drawings are objected to under 37 C.F.R. § 1.83(a) because they fail to show the "secondary bypass 304" in Fig. 44, as described on page 43 line 22 of the specification. Applicants respectfully submit a substitute corrected drawing for Figure 44 that includes a designation for "secondary bypass 304." It is believed that the formal objection to the drawings has been overcome through this replacement.

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### **II. Rejections under 35 U.S.C. § 102**

#### A. Enviropod

Claims 1, 2, 6, 10, 11, 14 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by New Zealand Patent Publication No. 299114 issued to Enviropod New Zealand Limited ("Enviropod"). In particular, the Office Action states that "Enviropod discloses an apparatus and a catch basin filtration system comprising: . . . (c) an initial high flow bypass, seen as outlet (14) . . . and (d) a secondary high flow bypass, seen as overflow opening (13) in Fig. 1." Applicants respectfully submit that Enviropod fails to anticipate the cited claims.

In order to anticipate a claim, a reference must include every material element of that claim either expressly or inherently. *See, e.g., Advanced Display Systems, Inc. v. Kent State*

*University*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). Independent claims 1 and 27 contain, *inter alia*, “(c) an initial high flow bypass situated within [a] filter body support” and “(d) a secondary high flow bypass.” Applicants respectfully submit that neither of these elements are in Enviropod. As described by and depicted in Figure 1 of Enviropod, outlet (14) is the *outlet to the storm water drain*, such that fluid passing through outlet (14) is not bypassing anything. Accordingly, Applicants respectfully submit that outlet (14) does not provide “an initial high flow bypass,” as that term is used and claimed in the present invention. Furthermore, outlet (14) is simply not situated within cage means (3) or any other “filter body support means,” as is specified for the “initial high flow bypass” of claims 1 and 27.

As also described by and depicted in Figure 1 of Enviropod, “overflow opening (13)” appears to be nothing more than a common curb inlet to a storm water drain. Applicants respectfully submit that the term “overflow” is used for this item in a manner that does not relate to the filtration system described in Enviropod. A common storm water drain usually comprises a catchpit (10), grate (11), curb edge (12), overflow opening (13) and outlet (14), regardless of whether a filtration means (2), cage means (3) and support meant (4) are installed. As described and illustrated in Enviropod, items 10-14 are clearly prior art in its system. Opening (13) is presumably termed “overflow,” because it provides an additional means of fluid entry into the storm water drain beyond grate (11), and not because it provides any bypass or “overflow” with respect to the installed filtration means (2). Accordingly, Applicants respectfully submit that “overflow opening (13)” does not represent a high flow bypass.

Applicants acknowledge that Enviropod does state that “When inflow exceeds outflow, the water level in the bag slowly rises until flow bypasses the filter through the overflow” (page 11 lines 10-11). However, Enviropod is not clear about the exact location of this overflow either

in this passage or elsewhere. It would not appear possible for “overflow opening (13)” to operate in this capacity, as this opening would tend to direct fluid away from the filter and not to bypass it. Nevertheless, Applicants acknowledge that Enviropod does vaguely disclose a bypass feature in ambiguous terms. However, Applicants maintain that this bypass is not shown to be “within [a] filter body support,” and that furthermore, no “secondary high flow bypass” is disclosed by Enviropod whatsoever. Because Enviropod fails to disclose these material elements of claims 1 and 27, Enviropod cannot anticipate these claims. Because each of dependent claims 2, 6, 10, 11, and 14 all depend from independent claim 1, Enviropod cannot anticipate any of these claims for at least the same reasons as those given for claim 1.

Regarding claim 2, Applicants respectfully submit that “overflow opening (13)” is an *inlet* to the storm water drain and that “outlet (14)” is an *outlet* to the storm water drain, such that fluid passes through overflow opening (13) (or grate (11)) before it passes through outlet (14). Accordingly, the additional element of claim 2 requiring that the “secondary high flow bypass passes excess fluid only after excess fluid has passed or attempted to pass through said initial high flow bypass” is not present in Enviropod in any event. Because Enviropod fails to disclose this material element of claim 2, Enviropod cannot anticipate this claim.

Regarding claim 6, Applicant respectfully submits that Enviropod does not disclose or suggest an “adjustable” high flow bypass, as required by this claim. Although Enviropod does disclose an “overflow opening (13)” in Figure 1, Applicants respectfully submit, as explained above, that this overflow opening (13) not a high flow bypass as presently claimed. In addition, claim 6 recites that this high flow bypass is *adjustable*. Applicants respectfully submit that “overflow opening (13)” is not adjustable, and that Enviropod fails to further disclose or suggest

a high flow bypass that is adjustable. Because Enviropod fails to disclose this material element of claim 6, Enviropod cannot anticipate this claim.

Applicants also submit that *In re Stevens* specifically states that “the provision of adjustability, where needed, is not a patentable advance,” and that this statement is derived from a preceding case, which states that “Adjustability is usually not a patentable subject matter unless the adjustability is made in a new and improved way.” *In re Brandt*, 20 C.C.P.A. 1005, 1006 (1933). Applicants respectfully submit that adjustability is in fact *not needed* for a high flow bypass to function properly, and that the adjustability of a high flow bypass provided by the disclosed invention is in fact *made in a new and improved way*. Accordingly, this line of case law does not mandate that the provision of adjustability as presently claimed necessarily involves only routine skill in the art or is not otherwise patentable.

In addition, regarding claim 10, the Office Action states that “Enviropod discloses that the filtration means (2) is made from a geotextile material or nylon or shade cloth, suitable for the filtration of suspended solids from water passing through the material.” Applicant respectfully submits, however, that because a geotextile, nylon or shade cloth material is by definition not *adsorbent*, that “the filtration means (2)” of Enviropod is not an adsorbent container, as is presently claimed. Regarding claim 11, the Office Action further states that “Inherently, the . . . filtration means may become displaced as water is filtered therethrough.” As discussed for claim 10, however, Applicants respectfully submit that the “filter bag (2)” of Enviropod cannot be considered an “adsorbent container,” as is presently claimed. Furthermore, Applicants respectfully submit that Enviropod neither discloses nor suggests that its filter bag (2) may become displaced as water is filtered therethrough. In so doing, Applicants respectfully point out that if a theory of inherency is relied upon to make a rejection, then a factual or

technical basis must be provided to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the prior art. *See* MPEP § 2112 (citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). Similarly, the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *See* MPEP § 2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993)). Because Enviropod fails to disclose these material elements of claim 10 and 11, Enviropod cannot anticipate these claims.

For at least the foregoing reasons, Applicants respectfully submit that claims 1, 2, 6, 10, 11, 14 and 27 are patentable over Enviropod and thus respectfully requests the withdrawal of this rejection.

B. Wilson

Claims 1, 2, 6, 10-12, 14 and 27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,093,314 issued to Wilson et al. (“Wilson”). In particular, the Office Action states that “Wilson discloses an apparatus and a catch basin filtration system comprising: . . . (c) an initial high flow bypass, seen as outlets (30) . . . and (d) a secondary high flow bypass, seen as grating (57) in Fig. 3.” Applicants respectfully submit that Wilson fails to anticipate the cited claims.

As noted above, in order to anticipate a claim, a reference must include every material element of that claim. Independent claims 1 and 27 contain, *inter alia*, “(c) an initial high flow bypass situated within [a] filter body support” and “(d) a secondary high flow bypass.” Applicants respectfully submit that neither of these elements are found in Wilson. As described by and depicted in Wilson, “outlets (30)” are simply permanently formed outlets within a housing for the intended usual direction of fluid flow. Accordingly, Applicants respectfully

submit that outlets (30) do not provide “an initial high flow bypass,” as that term is used and claimed in the present invention. As also described by and depicted in Wilson, “grating (57)” appears to be nothing more than a common grating inlet to a storm water drain. Applicants fail to see how grating (57) provides a bypass to the system in any way, and respectfully submit that grating (57) cannot possibly represent a high flow bypass as that term is used and claimed in the present invention.

Applicants acknowledge that Wilson does state that “Runoff which does not enter the interior 24 of drain insert 10, due to an obstruction, is thus allowed to pass through the overflow gap 63” (col. 6 lines 53-55). However, Applicants maintain that this bypass is not shown to be “within [a] filter body support,” and that furthermore, no secondary bypass is disclosed by Wilson whatsoever. Because Wilson fails to disclose these material elements of claims 1 and 27, Wilson cannot anticipate these claims. Because each of dependent claims 2, 6, 10-12, and 14 all depend from independent claim 1, Wilson cannot anticipate any of these claims for at least the same reasons as those given for claim 1.

Regarding claim 2, Applicants respectfully submit that “grate (57)” is an *inlet* to the storm water drain and that “outlets (30)” comprise an *outlet* to the disclosed filtration system of Wilson, such that fluid passes through grate (57) *before* it passes through outlets (30). Accordingly, the additional element of claim 2 requiring that the “secondary high flow bypass passes excess fluid only after excess fluid has passed or attempted to pass through said initial high flow bypass” is not present in Wilson in any event. Because Wilson fails to disclose this material element of claim 2, Wilson cannot anticipate this claim.

Regarding claim 6, Applicant respectfully submits that Wilson does not disclose or suggest an “adjustable” high flow bypass, as required by this claim. Applicants respectfully

submit that “outlets (30)” are *permanently formed* in the walls of housing 12, and are therefore not adjustable, and that Wilson fails to further disclose or suggest any high flow bypass that is adjustable. Because Wilson fails to disclose this material element of claim 6, Wilson cannot anticipate this claim. Applicants also resubmit their comments with respect to *In re Stevens* and *In re Brandt* provided above.

Regarding claims 10-14, the Office Action states that “Wilson discloses one absorbent container within the filter body.” Applicants respectfully submit, however, that claims 10-14 contain the element of “one or more *adsorbent* containers,” which is not the same as an adsorbent filter. Because Enviropod fails to disclose these material elements of claims 10-14, Wilson cannot anticipate these claims.

For at least the foregoing reasons, Applicants respectfully submit that claims 1, 2, 6, 10-12, 14 and 27 are patentable over Wilson and thus respectfully requests the withdrawal of this rejection.

### **III. Rejections under 35 U.S.C. § 103**

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson. In particular, the Office Action states that “The single filter (44) of Wilson can be viewed as an elongated boom.” Applicants respectfully traverse this rejection.

The single filter (44) of Wilson is described and depicted as a “pillow” by the referenced literature and not as an “elongated boom” as presently described and claimed. Applicants respectfully submit a pillow does not contain the same or similar dimensions as an elongated boom, and that it would not be obvious to modify Wilson accordingly, as this would tend to defeat the purpose of the pillow in Wilson (i.e. to substantially cover the cross-section of flow to



filter substantially all fluid passing therethrough). Accordingly, Applicants respectfully submit that claim 13 is patentable over Wilson for at least the foregoing reasons, and respectfully requests the withdrawal of this rejection.

### CONCLUSION

Applicants respectfully submit that all claims are in proper form and condition for patentability, and request a notification of allowance to that effect. It is believed that no fee is due at this time. Should any fee be required for any reason related to this document, however, the Assistant Commissioner is authorized to charge said fee to Deposit Account No. 08-3038, referencing Docket No. 11533.0012.CPUS04. The Examiner is hereby respectfully invited to contact the undersigned attorney at the number listed below with any questions, comments or suggestions relating to this application.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Justin A. White, Esq." followed by a stylized surname.

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